



Docket 13064US02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:

Bowers et al.

Serial No.: 10/634,618

Filed: August 5, 2003

For: Methods To Stabilize A Viscosity-Unstable Aqueous Dispersion Of Carbon

Art Unit: 1712

Examiner: Kugel, Timothy J

Confirmation No. 6586

CERTIFICATE OF MAILING

I hereby certify that on the date indicated below this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: May 31, 2006



David Z. Petty
Reg. No. 52,119

PRE APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets

Respectfully submitted,

Date: May 31, 2006

By: 

David Z. Petty
Reg. No. 52,119
Attorney for Applicants

McANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312) 775 - 8100

REMARKS

The present application includes claims 1-18. The Applicants have elected the invention of claims 1-10 and 18 and withdrawn claims 11-17. Pursuant to the Examiner's instructions, claims 11-17 were canceled. Claims 1-10 and 18 stand rejected by the Examiner. Specifically, the Examiner has maintained the rejection of claims 1-9 under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,476,580 ("Thorn"), the rejection of claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Thorn in view of U.S. Pat. No. 5,718,746 ("Nagasawa"), and the rejection of claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Thorn. The applicant respectfully submits that Claims 1- 10 and 18 are patentable for the reasons provided below.

I. Thorn Does Not Teach, Nor Suggest, Reducing The Alkalinity Of The Viscosity-Unstable Aqueous Dispersion Of Carbon By An Amount Effective To Reduce The Susceptibility Of The Carbon Dispersion To A Viscosity Increase

The Applicant respectfully submits that Thorn does not teach, nor suggest, reducing the alkalinity of the dispersion "by an amount effective to reduce the susceptibility of the carbon dispersion to a viscosity increase," as recited in claim 1. *See April 7, 2006 Amendment ("2006 Amendment") at pp. 5-6.* Rather, Thorn discloses a dispersion having a viscosity of 145 cps prior to adding potassium bicarbonate to the dispersion. *See 2006 Amendment at pp. 5-6.* The Examiner does not provide any explanation as to why adding potassium bicarbonate to a dispersion as described in Thorn inherently reduces the alkalinity of the dispersion "by an amount effective to reduce the susceptibility of the carbon dispersion to a viscosity increase," as recited in claim 1 and thus Thorn, for at least these reasons, does not anticipate claims 1-9. *See 2006 Amendment at pp. 5-6.*

II. The Combination Of Thorn And Nagasawa Does Not Disclose All The Limitations Of Claim 10

The Applicant respectfully submits that neither Thorn, nor Nagasawa, teaches or suggests reducing the alkalinity of the dispersion "by an amount effective to reduce the susceptibility of the carbon dispersion to a viscosity increase," as recited in claim 10. *See 2006 Amendment at pp. 6-7.* Additionally, neither Nagasawa, nor Thorn, teaches or suggests a "viscosity-unstable aqueous dispersion of carbon compris[ing] ammonia in a concentration sufficient to make it susceptible to a viscosity increase when exposed to the atmosphere" or "reducing the concentration of ammonia in the viscosity-unstable aqueous dispersion of carbon" as recited in claim 10. *See 2006 Amendment*

at pp. 6-7. While Nagasawa discloses “[a]s a pH controlling agent, there can be used aqueous ammonia,” Nagasawa does not explicitly or inherently teach ammonia in a viscosity-unstable aqueous dispersion of carbon in a concentration sufficient to make it susceptible to a viscosity increase when exposed to the atmosphere. *See* 2006 Amendment at pp. 6-7. Nor does Nagasawa explicitly or inherently teach reducing the concentration of ammonia in the dispersion of carbon as part of reducing alkalinity. *See* 2006 Amendment at pp. 6-7. Thus, at least for these reasons, the Examiner has not established a *prima facie* case of obviousness.

III. Claim 18 Is Not Obvious Over Thorn

Claim 18 recites a dispersion of carbon having “a viscosity of less than about 20 cps and a conductivity of less than about 3 mS.” *See* 2006 Amendment at pp. 7-9. Thorn discloses an aqueous solution having a viscosity in the range of 25-800 cps and does not teach or disclose the solution having a conductivity of less than about 3 mS, or any specific conductivity for that matter and therefore does not teach, nor suggest, all the limitations of claim 18. *See* 2006 Amendment at pp. 7-9. The Examiner argues that claim 18 is obvious over Thorn and that the Thorn composition would inherently have the claimed conductivity. *See* 2006 Amendment at pp. 7-9. However, the Examiner provides no support for these assertions of obviousness or inherency. *See* 2006 Amendment at pp. 7-9. Thus, at least for these reasons, the Examiner has not established a *prima facie* case of obviousness.

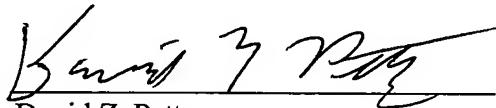
IV. Conclusion

The Applicant respectfully submits that the pending claims of the present application should be in condition for allowance at least for the reasons discussed above and requests reconsideration of the claim rejections. The Commissioner is authorized to charge any necessary fees, including the \$500 fee for the Notice of Appeal, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

Date: May 31, 2006

By:



David Z. Petty
Reg. No. 52,119
Attorney for Applicants

McANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312) 775 – 8100